

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

Status of the Claims

Upon entry of the present amendment, claims 1, 3-4, 6-18, and 20-22 will be pending in the present application. Claims 6-18 are currently withdrawn from consideration. Claims 1 and 4 have been amended herein. Claims 5 and 19 have been cancelled. Claims 20-22 have been added. Support for the recitations in claims 1 and 4 can be found in the specification, *inter alia*, at pages 36 and 39. New claims 20 and 22 recite the independent form of cancelled claim 5. Support for the recitation of “under stirring conditions at a temperature of 20 to 25°C” in claims 20 and 22 can be found in the present specification, *inter alia*, at pages 9, 51, 54, and 76. New claim 21 mirrors claim 3 but depends from new claim 20. No new matter has been added. Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. §§ 101 and 112

The Examiner has rejected claim 19 under 35 U.S.C. § 101 and 35 U.S.C. § 112, second paragraph, for not setting forth any steps involved in the process. Specifically, the Examiner asserts that the claims are indefinite where they merely recite a use without any active, positive steps delimiting how this use is actually practiced.

Claim 19 has been cancelled herein, which renders these rejections moot. Accordingly, Applicants respectfully request that the rejections be removed.

Issues under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1, 3-5, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Ikeda et al. '278 (US 2002/0117278) in view of Tadokoro et al. '392 (US 6,599,392), Nievandt et al. '719 (US 2004/0171719), and Reynolds et al. '962 (US 3,212,962) and as evidenced by "Characteristic of Raw Starch," Nippon Starch Chemical Co., LTD. Claims 5 and 19 have been cancelled, which renders the rejection moot as to these claims. With respect to the remaining claims, Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested.

Legal Standard for Determining Prima Facie Obviousness

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Exemplary rationales that may support a conclusion of obviousness include:

- (a) combining prior art elements according to known methods to yield predictable results;
- (b) simple substitution of one known element for another to obtain predictable results;
- (c) use of known technique to improve similar devices (methods, or products) in the same way;

(d) applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(e) “obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success

(f) known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

(g) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. *See* MPEP 2143.03.

The Present Invention and its Advantages

As amended, independent claims 1 and 4 recite, *inter alia*, that “the hydrophobic organic compound (A) and the emulsifying and dispersing agent (B) are evenly dispersed and enclosed within the water-soluble saccharide (C).” As discussed on pages 36-37 of the present specification, the combination of components (A) and (B) work to form a dense structure and fine voids. Component (C) provides a water-soluble solid matrix.

The present invention achieves unexpected results with an improved dispersion and an improved density. These advantages are supported by page 37 of the present specification, the test data of the present specification, and Figure 1.

Distinctions over the Cited Art

Ikeda et al. ‘278 disclose an emulsion obtained by emulsifying compound (A) with compound (B). However, as the Examiner admits, Ikeda et al. ‘278 fail to disclose a powder composition.

Ikeda et al. '278 also fail to disclose the "water-soluble saccharide (C)" as recited in claims 1 and 4 and the feature of the present invention that "the hydrophobic organic compound (A) and the emulsifying and dispersing agent (B) are evenly dispersed and enclosed within the water-soluble saccharide (C)."

Tadokoro et al. '392 disclose an ester of a polyhydric alcohol with a fatty acid but do not overcome the deficiencies of Ikeda et al. '278 discussed above. More specifically, Tadokoro et al. '392 fail to disclose the "water-soluble saccharide (C)" of the present invention and the feature of the present invention that "the hydrophobic organic compound (A) and the emulsifying and dispersing agent (B) are evenly dispersed and enclosed within the water-soluble saccharide (C)."

Tadokoro et al. '392 disclose a solid product in use, which is considered to be a solid product of the ester (col. 3, lines 51-54). Tadokoro et al. '392 also disclose a surfactant for the emulsifier, which is related to an emulsion liquid (col. 3, lines 54-57). Accordingly, the compound does not consist of powder particles.

Finally, Nievandt et al. '719, Reynolds et al. '962, and the Nippon Starch Chemical article do not disclose the "water-soluble saccharide (C)" of the present invention and the feature of the present invention that "the hydrophobic organic compound (A) and the emulsifying and dispersing agent (B) are evenly dispersed and enclosed within the water-soluble saccharide (C)."

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be disclosed by the prior art. As discussed above, the cited references fail to disclose all the claim limitations of independent claims 1 and 4, and those claims dependent thereon. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the outstanding rejection is respectfully requested.

For the reasons given above, the combination of references does not render the present invention obvious because the cited references do not disclose at least one feature of the present invention and its effects. Furthermore, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Any contentions of the USPTO to the contrary must be reconsidered at present.

Newly Proposed Claims 20-22

Applicants have newly proposed claims 20-22 in an effort to further define the scope of protection owed to Applicants. Applicants respectfully submit that claims 20-22 are allowable for the reasons given above.

Moreover, independent claims 20 and 22 recite, *inter alia*, that the method is done “under stirring conditions at a temperature of 20 to 25°C.”

In stark contrast, Ikeda et al. ‘278 disclose a water temperature of 70°C (paragraph [0117]).

As such, Applicants respectfully assert that claims 20-22 clearly define over the prior art of record, and an early action to this effect is earnestly solicited.

CONCLUSION

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case clearly indicating that each of claims 1, 3-4, and 20-22 are allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: November 18, 2008

Respectfully submitted,

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